



PATENT
Attorney Docket No.: 016845-000300US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Paul Chang et al.

Application No.: 09/215,421

Filed: December 18, 1998

For: TELECOMMUNICATIONS
TRANSMISSION TEST SET

Examiner: W.C. Schultz

Art Unit: 2664

SUPPLEMENTAL INFORMATION
DISCLOSURE STATEMENT UNDER
37 CFR §1.97 and §1.98

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

JUN 04 2004

Technology Center 2600

Sir:

Applicants previously submitted a Declaration Under 37 C.F.R. § 1.131 to establish an effective invention date prior to the October 22, 1997 filing date of U.S. Patent No. 6,064,721 to Mohammadian et al. (the '721 patent).

Acterna LLC of Germantown, Maryland, (formerly known as Telecommunications Techniques Corporation) the assignee of the '721 patent, has sued Applicants' assignee, Sunrise Telecom, Inc. of San Jose, California, alleging that products that are the subject of the present application infringe various claims in Mohammadian and related patents. The family includes, in addition to U.S. Patent No. 6,064,721, U.S. Patent Nos. 6,385,300 and 6,590,963.

Applicants have, through their attorneys, become aware of the Mohammadian patent family file histories and the prior art cited therein. This Information Disclosure Statement is being filed to make the prior art cited in the Mohammadian patents of record in this application.

Additionally, during the prosecution of U.S. Patent No. 6,385,300, Acterna made of record an offer for sale that took place more than one year prior to the October 22, 1997, filing date of the '721 patent. Acterna filed two declarations detailing the nature of the offer for sale and the state of development of the product that was the subject of the '721 patent. Acterna took

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the position that the invention that was the subject of the '721 patent and the continuation patents was not reduced to practice or otherwise "ready for patenting" at the critical date.

Applicants are including with this Information Disclosure Statement those portions of the Mohammadian file histories that include the Declarations and other prosecution papers dealing with the offer for sale. Specifically, Applicants are submitting (as their Exhibits A through F) the following documents from the file histories of U.S. Patent Nos. 6,385,300, and 6,590,963. For the Examiner's convenience and reference, these documents are also referred to with their original Patent Office Paper No.:

Patent No.	Document	USPTO Paper No.	Exhibit
6,385,300	Information Disclosure Statement	7	A
	Declaration of Gunter Woytowitz and Exhibits A-F thereto	8	B
	Office Action mailed 06/06/01	9	C
	Amendment	11	D
	Declaration of Timothy W. Smith and Exhibit A thereto	N/A	E
6,590,963	Information Disclosure Statement (including copy of Information Disclosure Statement from U.S. Patent No. 6,385,300)	6	F

Although Acterna took the position that the invention had not been reduced to practice at the critical date, Applicants encourage the Examiner to consider the Declarations and Exhibits to the extent that they may be material to the examination of the present application.

The references cited on the attached PTO/SB/08B forms are the references cited in the Mohammadian cases, and are being called to the attention of the Examiner. Copies of these references are enclosed.* It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant

*Four references, Itronix Brochure, "One Good Thing Deserves Another," 1992; Itronix Brochure; "These Problems are History," 1989; Itronix T4000 Teletester Operator Guide, 1992; and DE 8703026.8, listed on the front of U.S. Patent No. 6,590,963, are currently unavailable, but will be furnished when obtained.

information, and no inference should be made that the information and references cited are, or are considered to be material to patentability because they are in this statement. No inference should be made that the information and references cited are prior art merely because they are in this statement.

This IDS is being filed before the mailing date of the final Office Action or Notice of Allowance. Please charge the IDS fee of \$180 to Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



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Attachments:

Exhibits A through F
PTO/SB/08B (two pages) with copies of 46 references

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